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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte LARS SEVERINSSON

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035
Technology Center 3600

Oral Hearing Held: May 13, 2010

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,
LINDA E. HORNER and KEN B. BARRETT, *Administrative Patent*
Judges.

APPEARANCES:

ON BEHALF OF THE APPELLANT:

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1 The above-entitled matter came on for hearing Thursday, May 13,
2 2010, commencing at 9:01 a.m., at the U.S. Patent and Trademark Office,
3 600 Dulany Street, Alexandria, Virginia, before Victor Lindsay, a Notary
4 Public.

5 THE USHER: Good morning. Calendar No. 54, Appeal No. 2008-
6 005060. Mr. Oberdick?

7 JUDGE MacDONALD: Have you been here before?

8 MR. OBERDICK: I have, yes.

9 JUDGE MacDONALD: Okay, so you know you have 20 minutes to
10 do your presentation. You can begin whenever you're ready.

11 MR. OBERDICK: Okay, thank you. Okay, maybe just a little bit of
12 background would help. You know, I don't know that we have to get into
13 too much of the technical details given the issues that we have, but basically
14 what we have here is we have a brake caliper assembly. Typically how
15 these things had worked in the past with respect to the issues that are
16 pertinent here is that the caliper housing traditionally had been formed in
17 two pieces. There was a housing piece with a cavity, and basically what
18 would happen is you would provide the cavity -- you would provide the
19 piece with the cavity, the housing with the cavity, and the installer would
20 take a whole bunch of other pieces, which you can see in the patent,
21 basically the guts of the actuation unit, and assemble those pieces within the
22 cavity of the housing, and it was very difficult to do. It's a tight area. It was
23 very difficult to assemble all those pieces within the cavity of the housing.

24 And then after all of those pieces were assembled within the cavity,
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1 they would slap a cover on the back and screw the cover in with some bolts.
2 You know, that was, you know, so basically that was the issue that the
3 Applicants here were trying to improve upon and, you know, clearly this is
4 an improvement patent. So basically what they discovered was that they
5 could take all of these pieces, the guts, and preassemble them as a unit,
6 rather than assembling them inside the cavity, preassemble them as a unit,
7 and then just slap them in. They would preassemble them as a unit, attach
8 them to the cover in the disclosed embodiment, the best mode at the time we
9 filed the Application, and then slap the whole thing together all in one step.
10 So the preassembly as a unit was what they considered to be one of the
11 Inventions, and then the other Invention had to do with the particular
12 configuration of one of the pieces, this so-called wedge shape configuration
13 to one of the pieces. Basically, all along that's what the Applicants believed
14 their Invention was, preassembly and wedge shape.

15 Obviously, one of the very important aspects here is the cover, and
16 we'll get into that. But I would just say right from the get-go that I believe
17 that the cover itself, the presence of the cover, was never believed to be part
18 of the invention. If you look at the original Application or the original
19 Patent 5,833,035, the very first paragraph where we talk about the
20 background technical field talks about the disparate caliper, the housing, the
21 cover and some of the various pieces that were admitted to be in the prior art
22 all along. You know, that basically is described in the prior art, and
23 obviously the cover is right up there at the very beginning. So just at the
24 outset I'd, you know, just like to point that out, that the Applicants never
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1 believed that the presence of the cover was inventive and acknowledge that
2 that was in the prior art from the very beginning.

3 So what we're concerned with here is the issue of --

4 JUDGE MacDONALD: Excuse me, but aren't they doing that with
5 everything that's in the claim, acknowledging that it's in the prior art, every
6 component that's here is in the prior art?

7 MR. OBERDICK: Well, again, that was --

8 JUDGE MacDONALD: That's not the point of the invention.

9 MR. OBERDICK: I'm sorry, the existence of the --

10 JUDGE MacDONALD: That new points are added is not the point of
11 the invention. It's the interconnection of those parts that's --

12 MR. OBERDICK: No, that's -- that's exactly right. But you know, I
13 think in, you know, I think we'll kind of get to that. I think that the
14 preassembly of the parts is what was considered to be the invention, not that
15 that particular part was necessary. But again I think, you know, maybe we
16 can, you know, we can get to that.

17 So what we have here is recapture. Basically there's no prior art that's
18 cited against the Application. The Examiner, in fact, to get to your point, the
19 Examiner has acknowledged that the claim is patentable without the cover,
20 that the preassembly and the wedge-shaped configuration are what the
21 invention is, that the cover is not required for novelty, and no argument was
22 made that the cover was required for novelty, and the Examiner has said that
23 that is patentable over the prior art.

24 JUDGE HORNER: But that's not the test for recapture, right?

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1 MR. OBERDICK: No, but again, that is not, and obviously we'll be
2 getting to the statements made by the Applicant.

3 So again, the three-part test for recapture, you know, I'm sure you
4 know what the three-part test is. We're not disputing the first part and the
5 third part of the test. Really the sole issue is the second part of the test,
6 determining whether the broader aspects of the reissued claims relate to the
7 surrendered subject matter. Here there were no -- we believe that there were
8 no claim amendments to add the cover. The cover was unfortunately in the
9 claims from the very beginning in the original case. So this isn't a case
10 where we're talking about adding the element to the claim. We're --

11 JUDGE MacDONALD: Except that's not the standard. It's the
12 limitations and there were --

13 MR. OBERDICK: Exactly, so --

14 JUDGE MacDONALD: -- limitations regarding the cover were
15 added.

16 MR. OBERDICK: Limitations regarding -- again, the cover was in
17 there from the beginning, but limitations including the cover, unfortunately
18 yes. The cover was included in the preassembly. But again, it was not
19 argued that the cover being part of the preassembly was required for novelty.
20 It was just the preassembly of -- you have all these components.
21 Preassembling them is where the novelty was. Unfortunately, again, the
22 attorney who drafted the case, you know, basically assumed that the cover
23 was one of those parts, because that's what had traditionally been the case.
24 But again, the invention was related to the preassembly of parts, and

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1 unfortunately the cover, and this is part of the error on the part of the
2 attorney who originally prosecuted the case, the --

3 JUDGE MacDONALD: Except what I think I'm hearing you say is
4 the error is the attorney made a statement or amended the claim in a way that
5 led the public to believe something that may not be the case and that's not --
6 doesn't -- that isn't the kind of error that reissues are intended to correct.

7 MR. OBERDICK: Well, if you'd like to, you know, we can turn --

8 JUDGE MacDONALD: The public relied on that.

9 MR. OBERDICK: -- right, we can turn right to the statements that
10 were made. I, you know, I would like to again, you know, keep in mind as
11 we're looking at these statements the test that the Federal Circuit has
12 consistently applied in cases like this.

13 JUDGE HORNER: Before we go to the statements, can we go back
14 just for a minute to the claim amendment itself.

15 MR. OBERDICK: Sure.

16 JUDGE HORNER: Because it seems to me like the original claim
17 was claiming simply a disc brake caliper, and I don't see where the
18 preassembly is recited in the original Claim 1. The concept of an assembly
19 only comes in in the first amendment to Claim 1 where you added an
20 interconnected disc brake caliper assembly. So the word "assembly" was
21 added there, and then additionally what was added was that you have the
22 assembly connected to the cover. That was also added. So the concept of
23 preassembly to me only seems to come into the claim after the claim was
24 amended for the first time.

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1 MR. OBERDICK: Okay, are we going back to the -- there's been
2 three cases here. I'm just getting a little confused as to --

3 JUDGE HORNER: I'm looking at the claims as originally filed on
4 April 27th, 1997 as compared to the amendment that was filed January 29th
5 of 1998.

6 MR. OBERDICK: Okay. And the question is --

7 JUDGE HORNER: The question is does the original claim filed in
8 1997 include the concept of preassembly?

9 MR. OBERDICK: No, it appears that it doesn't. Again, I think that
10 that is part of, you know, part of the error that we are trying to fix.

11 Okay, the -- basically, you know, just very briefly again because, you
12 know, I'm sure you're aware of the case law. But you know, the standard
13 that was -- that has been consistently applied in the recent decisions that we
14 talk about in the Brief require unmistakable assertions to the Patent Office,
15 not incidental or unfortunate or accidental, and I would just refer you to take
16 a close look, if you would, at the *Medtronic* case in particular where in that
17 case actually, you know, claim amendments were made by the Examiner
18 which basically took one of the embodiments out of the coverage of the
19 claims, and even there the court said that was -- it was an accident. There
20 was no intent basically --

21 JUDGE HORNER: But there was no art rejection in that case.

22 MR. OBERDICK: No, but again, I'm just saying that in that case,
23 though, even their claim amendments were made, and the Federal Circuit
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1 still said that those claim amendments were accidental. Here what we're
2 saying --

3 JUDGE HORNER: Right, they looked at the correspondence between
4 the prosecuting attorney and the Examiner and the Inventor, and they also
5 looked at the fact that the Examiner characterized those Examiner
6 amendments as minor wording changes. What evidence do we have here in
7 the record that what you've made were minor wording changes or something
8 akin to what happened in the trial?

9 MR. OBERDICK: Right. Okay, you know, if we could look at the
10 statements that the Examiner is relying on for the finding of recapture, and
11 again, you know, I would just, you know, keep in mind that the same
12 Examiner prosecuted this case, you know, Examiner Schwartz, from the
13 very beginning and even he, you know, it was his understanding that there
14 was no recapture. I personally -- I discussed it with him on the telephone.

15 JUDGE MacDONALD: The real problem, the issue here is what the
16 public would have concluded, a reasonable artisan in this field, when they
17 went through this record as to what was being said, not this particular
18 Examiner.

19 MR. OBERDICK: Right, if there were unmistakable assertions, but I
20 think that that informs, you know, because he was intimately involved. He
21 was the one that the statements were being made to, so I think how he
22 interpreted those statements, you know, is pertinent at least, although I know
23 not dispositive.

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1 But if you turn basically to the statements that he refers to in the
2 response in the original case, the 08/817,769, there was a response filed by
3 the Applicant that on January 28th, 1998, that's one of the two papers that
4 he's pointing to, and basically he's pointing to the statement beginning at the
5 very end of page 6 over to page 7 that the Parent Claim 1 is amended to
6 better structurally define Applicant's novel feature wherein the housing and
7 the cover members are structured with the entire braking unit carried by the
8 cover independently from the housing to be inserted as a unit.

9 But I would ask you just to read the next paragraph, too, in
10 conjunction with that which the Examiner does not say. Thus to overcome
11 the 35 U.S.C. 102 rejection, the claimed structure is now more distinctly
12 defined over Anthony, *et al.* which discloses no such modular unit. Now
13 again, that statement doesn't say which discloses no cover, which discloses
14 no modular unit including a cover. Basically it's, you know, that's what the
15 Applicant believed that the novel element was was no such modular unit,
16 and I think that that's what the skilled artisan, you know, how they would
17 interpret that. You know, the distinction being made with Anthony, *et al.*
18 was the modular unit and had nothing, you know, not the presence of the
19 cover, again because the cover Applicant recognized had been known, you
20 know, for decades.

21 JUDGE BARRETT: You talk about how the Applicant recognizes,
22 but the public reading this, a skilled artisan, wouldn't they understand that a
23 modular unit is referring back to the previous paragraph talking about the
24 entire braking unit carried by the cover?

1 MR. OBERDICK: Well, again, the entire braking unit carried by the
2 cover. So the unit is being -- the braking unit is being carried by the cover.
3 The, you know, the modular unit being referred to is the unit that is being
4 carried by the cover. You know, the braking unit is generally the guts,
5 what's inside the caliper housing/cover. You know, so again it's -- it was the
6 modularity of the braking unit that was being argued to be where the novelty
7 was.

8 And I think it's -- there's a similar, you know, it's similar with respect
9 to the other arguments that the Examiner is pointing to, and this is the
10 response filed in the first reissued case, 09/324,506. When you get to page 5
11 of the response that's being cited, basically the -- 1, 2, 3, 4, 5, 6, 7, 8, 9, 10,
12 11, 12 -- line 20, you know, I think again Anthony is being distinguished,
13 and it's stated and even underlined, clearly cited, the Anthony mechanism
14 conversely is not disclosed as a remotely assembled mechanism adopted for
15 insertion as a unit. The unit may be manufactured separately as disclosed in
16 Applicant's column 2, 27 to 32. Again, I think one skilled in the art would
17 know what the mechanism is. You know, the cover is just a part of the
18 caliper housing essentially. It is not generally considered part of the
19 mechanism, the brake mechanism. The brake mechanism is all of the guts
20 that are included within the caliper housing/cover. And really, you know,
21 basically what happened here was just that the, you know, the state of the art
22 at that time that this was filed way back was again that you had a two-piece
23 caliper housing unit, the housing and you had the cover, and unfortunately
24 the cover was included, you know, in -- as part of this. It was, you know,

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1 basically saying that you would -- you could attach the unit, the modular unit
2 which is where the invention is, to the cover and then slap them together.

3 JUDGE MacDONALD: Yeah, but that's not what the statement in
4 column 2 of the specification says. It says the cover and the rest of the
5 mechanism are also held together as a unit.

6 MR. OBERDICK: Yes, it's --

7 JUDGE MacDONALD: It's -- the cover is part of the unit in the
8 disclosure. Is there something else in the disclosure that makes it clear that
9 oh, that was just a misstatement? Is there something in here where -- is there
10 a drawing describing the unit, and it doesn't include the cover? Is there
11 anything that would lead someone reading through this record to say ah,
12 well, they said unit over there included the cover, but that's just a mistake,
13 because everywhere else the unit is only the inside the guts.

14 MR. OBERDICK: No, I mean frankly there's not but that -- I would
15 submit that that's not the test for whether or not --

16 JUDGE MacDONALD: But the test is what someone skilled in the
17 art reading this is going to understand that you intend your invention to be,
18 not what the prior art -- perhaps in the prior art when they said unit they
19 meant the inside. But if you define it differently here, that's how you
20 defined unit, and that's how they're supposed to read it in this record and I'm
21 not -- I'm seeing a specific statement that the unit includes the cover and I'm
22 not -- and when I went through the record, I'm not seeing something else, at
23 least it's not jumping out to me, where it contradicts that.

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1 MR. OBERDICK: Yes, I would agree there's nothing, you know, that
2 was the only, you know, that was the best mode. That was the only
3 embodiment disclosed. But again, the question is whether, you know, I
4 believe not how one would reasonably interpret, you know, the statements
5 that were made but whether there was unmistakable assertion that that is
6 required for patentability.

7 JUDGE MacDONALD: Well, but isn't this more the situation where
8 the embodiment you're trying to cover now is obvious over the -- what was
9 in this claim?

10 MR. OBERDICK: Is it obvious? Yes, you know, frankly what
11 happened was that --

12 JUDGE MacDONALD: But there's no indication here from the
13 inventor that they intend that to be their invention.

14 MR. OBERDICK: Well, I think what was intended to be the
15 invention was the preassembly of the brake mechanism as a unit and, you
16 know --

17 JUDGE MacDONALD: But where is that statement in here? I'm
18 seeing a statement, and the statement includes the cover as part of the unit.

19 MR. OBERDICK: Yes. You know, again because unfortunately that
20 was the, you know, that was part of the mistake that is trying to be cured is
21 that the one who -- the person who drafted this application unfortunately and
22 mistakenly stated that the cover would be part, you know, was part of this
23 modular unit. You know, that -- again, that was not the intent, you know,
24 that was not the invention, and it's not required for patentability, and no
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1 argument was made that the cover being part of the modular unit is part of
2 what defines over the prior art.

3 JUDGE MacDONALD: I follow what you're saying, and I think that
4 a correction could be made if the public didn't look at this and -- this record
5 and wasn't led in a certain direction by the statements in here. And I think
6 what is in front of us, the public has to be able to reasonably rely on this, and
7 a reasonable reading of this is the cover is part of the invention. If this
8 connection wasn't made in here, then I think maybe I can see where you're
9 coming from, because the public wouldn't have relied on all of these things
10 together. But you've got a specific statement that the cover is part of the
11 unit. You've got the amendments that were made. You've got the statements
12 in the amendment that are not clear one way or the other. I think adding
13 everything together, the public or an artisan would reasonably interpret this a
14 certain way. And they are being put on notice of this and have, you know,
15 they can expect to rely on what is here in terms of what the patent will cover.

16 MR. OBERDICK: Yes, you know, I can understand obviously what
17 you're saying. But you know, to some extent that would be the case in any
18 broadening reissue where, you know, the public is going to be relying on
19 some -- on the claims and on what the specification says so that I would just
20 submit that that is not the test that is applied by the Federal Circuit. You
21 know, I have many cases here and have not seen that test applied. The test
22 that's consistently applied is whether there were unmistakable assertions,
23 you know, that were made by the Applicant to surrender that subject matter.

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1 And at best, even I think you just stated that there were unclear statements
2 that were made.

3 JUDGE MacDONALD: No, some of them were unclear, but there are
4 no clear ones in the opposite direction. There are clear ones here that the
5 cover is part of the unit. There are some unclear ones, but there are no clear
6 indications that it is not part of the unit.

7 MR. OBERDICK: I would agree with that, but again, I don't believe
8 that that is what the test is. I don't believe that there is -- there are
9 unmistakable assertions that the Applicant intended to give up the coverage
10 that the Examiner has agreed is patentable. I think that that's what the
11 Federal Circuit test is and has been in all of the recent cases.

12 I believe that's all I have.

13 JUDGE MacDONALD: Okay. Any questions, Judge Barrett,
14 Judge Horner?

15 Thank you.

16 MR. OBERDICK: Thank you.

17 Whereupon, the proceedings, at 9:31 a.m., were concluded.

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